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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,704	10/11/2001	George Bradley Hobbs	10006501-1	2165

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,704

Applicant(s)

HOBBS, GEORGE BRADLEY

Examiner

Tan Dean D. Nguyen

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Status

Claims 1-10, 11-14 are pending and are treated as followed.

Claim Rejections - 35 USC § 112

1. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the preamble cites "a computer-implemented method" but the claim fails to cite "computer" in the body of the claim. Applicant is requested to cite the term "computer" in the body of the claim to overcome this rejection. Note that if applicant taking other option of taking the term "computer" out of the claim completely, this would make the claim susceptible for a 101 rejection in the next office action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Art Unit: 3629

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-10 (method) are, 11-14 (apparatus) are rejected under 35 U.S.C. 102(e) as being anticipated by SEVCIK et al (US Patent 6,330,542).

As for Independent method claim 1, SEVCIK et al discloses a computer-implemented method for completed estimating printing job prior to printing by calculating the printing job and postage (freight cost) of a print job comprising the two steps of:

- (a) provide an electronic print job having a set of predefined electronic print job attributes, and
- (b) calculate a postage (freight/shipping/delivery cost/charge) for the print job using the set of predefined electronic print job attributes. [see Fig. 1A (68), Fig. 4, Fig. 7 (turn around, shipping, size, panel, binding, paper weight, Fig. 9 (calculate freight charge), (generate quote/price (92), col. 9, lines 2-4, 43-50].

As for dep. claim 2, which deals with a 1st well known variable for determining the postage (freight cost) which is calculating a weight for the printing job using weight determining factor from the set of attributes, this is taught in col. 9, lines 43-45, lines 1-5, col. 8, lines 60-67, Figs. 7, 18.

As for dep. claim 3, which deals with a 2nd well known variable for determining the postage (freight cost) which is determining a parcel size for the printing job using weight determining factor from the set of attributes, this is fairly taught in col. 8, lines 60-65 (size), col. 9, lines 43-45, lines 1-5, or Figs. 7, 18.

As for dep. claim 4, which deals with a 3rd well known variable for determining the postage (freight cost) which is determining a delivery method for the printing job, weight determining factor from the set of attributes, this is fairly taught in col. 8, lines 60-65 (size), col. 9, lines 43-45 (most competitive freight), lines 1-5, or Figs. 7, 18.

As for dep. claim 5, which further limits the weight-determining factors by selecting of the paper type, printing type, # of pages, binding materials, etc., these are well known parameters for determining weight and are taught in Fig. 18 (paper weight (46), size options, binding materials), Fig. 7, Fig. 5, volume (2500 cards), and col. 9, lines 43-50 (calculate the weight of the order based on the quantity and paper weight).

As for dep. claim 6-7, which further limits the delivery-determining factor by well known step such as selecting a carrier, this is taught in 8:65, or col. 9, lines 1-5, 40-45, Fig. 7.

As for dep. claim 8-9, which further limits the size-determining factor by well known steps such as selecting the media type, number of pages, binding materials and by a user, these are taught in col. 8, lines 60-65 (size), col. 9, lines 43-45, lines 1-5, or Figs. 7, 18.

As for dep. claim 10, this is taught in Figs. 7-13 "calculating a freight charge or cost" and col. 9, lines 45-50 ("displaying vendor with the most competitive 1) printing job and 2) freight cost and assign a reference number to the quote at 70").

As for independent claim 11 which deals with a calculator comprising a storage medium having plurality of machine-readable instructions for the steps (a) and (b) as in independent method claim 1, it is rejected for the same reason set forth in claim 1

Art Unit: 3629

above with respect to the limitation that the SEVCIK et al deals with automated Internet quoting and procurement system and process for commercial printing.

As for dep. claims 12-14 (part of claim 11) which have similar limitations to dep. claims 2-4, respectively, they are rejected for the same reasons set forth in claims 2-4 above.

In summary, the teachings of SEVCIK et al which deals with automated Internet quoting of printing jobs including accurately estimating 1) printing job and 2) the postage (freight cost) to provide completed estimated costs prior to printing hard copies overcome the problem of electronic printing job mentioned by the application in the "Background of the Invention" and meet the scope of the claimed invention. The various non-essential differences in determining printing job variables/parameters or freight-cost determining factors are within the skilled artisan as disclosed by SEVCIK et al above or would have been obvious as routine experimentation, absent evidence of unexpected results. Adjustment or changing of printing job variables/parameters or freight-cost determining factors is considered as optimizing operating conditions or result effective variables and the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions and would have been obvious to the skilled artisan. In re Aller, 105 USPQ 233.

No claims are allowed.

Art Unit: 3629

4. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113

Or see <http:pair-direct@uspto.gov>

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn
June 27, 2004


DEAN T. NGUYEN
PRIMARY EXAMINER